

## **REMARKS**

### **I. Introduction**

With the addition of claims 32 to 36, claims 15 and 18 to 36 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable and reconsideration is respectfully requested.

### **II. Rejection of Claims 15, 18, 23 and 28 to 31 Under 35 U.S.C. § 103(a)**

Claims 15, 18, 23 and 28 to 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over United States Patent No. 6,473,609 ("Schwartz") in view of United States Patent No. 6,088,594 ("Kingdon"). Applicants respectfully submit that this rejection should be withdrawn for the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 15 relates to a method for transmitting messages between at least one main station and a terminal via a telecommunications network, which method includes providing a matching device between the at least one main station and the terminal, controlling a message exchange using the matching device in dependence upon at least one input from the terminal or the at least one main station, and matching, by the matching

device, at least one characteristic for transmission of the message to the at least one input, wherein the at least one characteristic is a data type, a data format and/or a transmission mode. Claim 15 further recites that **the message is transmitted in a format that is determined in dependence upon a format request made by the terminal or the at least one main station.**

Schwartz relates to a navigation of the Internet by two-way interactive communication mobile devices that are capable of wireless communication on the Internet via a link server with service providers or network servers. (See Schwartz, Abstract.) As admitted on page 5 of the Office Action, Schwartz does not disclose a message transmitted between a terminal and at least one main station in **a format that is determined in dependence upon a format request made by the terminal or the at least one main station**, as recited in claim 15.

Kingdon relates to a telecommunications system and method, which involves a terminal-based browser within a mobile station that connects to web-based location services via a mobile positioning center, so that a graphical presentation of the current location of the mobile station may be displayed thereon in a manner selected by the mobile subscriber. (See Kingdon, Abstract). In this regard, it is respectfully submitted that Kingdon does not disclose a message transmitted between the mobile station and the mobile positioning center in a **format that is determined in dependence upon a format request made by the mobile station or the mobile positioning center**. The Examiner asserts on page 5 of the Office Action that the Abstract and col. 4, lines 9 to 55 of Kingdon disclose a message transmitted in a format that is determined in dependence upon a format request made by a terminal or at least one main station. However, this cited portion of Kingdon only concerns the content of the message, **rather than its format**. In particular, the format request sent between the mobile station and the mobile position center merely determines the format of the returned location information (e.g., a street address or a location on a map) contained in the message, **but not the format of the message itself**. Still further, such a format request does not relate to at least one characteristic for transmission of the message, as required by claim 15.

Although Kingdon purports to support the transmission of complex responses involving, for example, bit-mapped graphics, such complex transmission has nothing to do with the format request. Instead, the format request is merely used to determine which location information is to be transmitted, i.e., whether, for example, the street address or a location on a map is to be sent. (See Kingdon, col. 4, lines 46 to 50). Indeed, the data type used for the transmission or the data format of the bit-map graphics used for the transmission is not requested by the mobile station, but instead is made available via a web-based application 330 and the WAP protocol so that the format used for transmission is adapted automatically to the mobile station, and therefore **not determined in dependence upon the format request**, as required by claim 15. Accordingly, for at least these reasons, it is respectfully submitted that the features of claim 15 discussed above are not in any way disclosed or suggested by the combination of the Schwartz and the Kingdon references.

It is also respectfully submitted that a person having ordinary skill in the art would not be motivated to modify Schwartz in view of the Kingdon reference in an attempt to arrive at the claimed invention of the present application, because the **automatic format adaption** for data transmission referred to in Kingdon teaches away from the claimed subject matter of the present application, i.e., a request regarding the format used for transmission cannot be achieved. Moreover, even if there were some motivation to combine the teachings of the applied references, which does not exist, the resulting system would still not include the features of claim 15 discussed above.

Accordingly, it is respectfully submitted that claim 15 is allowable for all of the above reasons. Also, since claim 29 recites features analogous to claim 15 and since claims 18, 23 and 28 depend from claim 15, it is respectfully submitted that these claims are allowable for the same reasons that claim 15 is allowable.

Regarding claim 30 and 31, these claims recite a method and a device, respectively, for transmitting messages between at least two main stations. The Examiner admits on page 8 of the Office Action that Schwartz does not disclose at least two main

stations, but the Examiner asserts that Kingdon discloses at least two main stations, i.e., "Kingdon discuss[es] connect[ing] a mobile to one [or] more servers on the internet via the internet addresses," at col. 4, lines 38 to 45. Applicants respectfully disagree with this assertion, since col. 4, lines 38 to 45 of Kingdon merely state that the TCP/IP suite of protocols is used to establish a connection between the mobile station 200 and the web-based location application 300, and that, in general, the TCP/IP protocol suite defines the address of **all nodes on the Internet**. In this regard, the term "nodes" is used in a general sense to refer to all elements of the Internet responsible for routing of packets therein, such as, for example, a switching exchange element, and the term "nodes" in no way implies the disclosure of a **plurality of main stations**, as recited in claims 30 and 31. Indeed, Kingdon makes reference to the establishment of only a single TCP/IP connection, which by definition, cannot support more than one main station.

For the foregoing reasons, Schwartz and Kingdon, either individually or in combination, fail to disclose, or even suggest, a method or a device for transmitting messages between at least two main stations, as recited in claims 30 and 31. It is therefore respectfully submitted that it would not have been obvious to modify the invention of Schwartz as suggested because Kingdon does not disclose, or even suggest, at least two main stations. Furthermore, even if there were some motivation to combine the applied references, the resulting combination would not provide the claimed invention of claims 30 and 31. Accordingly, for at least these reasons, it is respectfully submitted that claims 30 and 31 are allowable.

In view of the foregoing, it is respectfully requested that the obviousness rejection of claims 15, 18, 23, and 28 to 31 be withdrawn.

### **III. Rejection of Claims 19, 20 and 22 Under 35 U.S.C. § 103(a)**

Claims 19, 20 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz in view of Kingdon and in further view of United States Patent No. 6,138,158 ("Boyle").

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Boyle reference does not cure the critical deficiencies of the Schwartz and Kingdon references (as explained above) with respect to parent claim 15, from which claims 19, 20 and 22 depend. Indeed, the Office Action does not allege that Boyle cures the critical deficiencies. It is therefore respectfully submitted that claims 19, 20 and 22 are allowable for at least the same reasons that claim 15 is allowable. Accordingly, withdrawal of the obviousness rejection of claims 19, 20 and 22 is respectfully requested.

**IV. Rejection of Claim 21 Under 35 U.S.C. § 103(a)**

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,473,609 ("Schwartz '609") in view of Kingdon and in further view of United States Patent No. 6,243,739 ("Schwartz '739").

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Schwartz '739 reference does not cure the critical deficiencies of the Schwartz '609 and Kingdon references (as explained above) with respect to claim 15, from which claim 21 depends. Indeed, the Office Action does not allege that Schwartz '739 cures the critical deficiencies. It is therefore respectfully submitted that claim 21 is allowable for at least the same reasons that claim 15 is allowable. Accordingly, withdrawal of the obviousness rejections of claim 21 is respectfully requested.

**V. Rejection of Claims 24 to 27 Under 35 U.S.C. § 103(a)**

Claims 24 to 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz in view of Kingdon and in further view of United States Patent No. 6,560,640 ("Smethers").

It is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Smethers reference does not cure the critical deficiencies of the Schwartz and Kingdon references (as explained above)

with respect to claim 15, from which claims 24 to 27 ultimately depend. Indeed, the Office Action does not allege that Smethers cures the critical deficiencies. It is therefore respectfully submitted that claims 24 to 27 are allowable for at least the same reasons that claim 15 is allowable. Accordingly, withdrawal of the obviousness rejections of claims 24 to 27 is respectfully requested.

**VI. New Claims 32 to 36**

New claims 32 to 36 do not add any new matter and are supported in the specification. The new claims 32 to 36 depend from claim 15 and are therefore allowable at least for substantially the same reasons discussed above with respect to claim 15.

Independent of the above, Applicants note that claims 32 to 36 further define the “data format” or “data type” recited in parent claim 15. The features recited in claims 32 to 36 are not taught or suggested in the cited references. For example, the features recited in claims 32 to 36 are clearly different from merely compressing mark-up language files into SDD files, as disclosed in Schwartz. For this additional reason, claims 32 to 36 are allowable over the cited references.

Appl. No. 10/089,623  
Reply to Office Action of May 10, 2004

**CONCLUSION**


It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.


Respectfully submitted,

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Dated: 8/26/04

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